

## **REMARKS**

### **I. Introduction**

With the addition of new claims 12 to 14, claims 1 to 14 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

### **II. Rejection of Claims 1 and 11 Under 35 U.S.C. § 102(e)**

Claims 1 and 11 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0218458 ("Seger et al."). Applicant respectfully submits that Seger et al. do not anticipate the present claims for at least the following reasons.

As an initial matter, claim 1 relates to **an inductive sensor**, and claim 11 relates to a rotary encoder that includes **an inductive sensor**. In stark contrast, Seger et al. relate to an apparatus that operates on a **magnetic principle**. Indeed, Seger et al. make no mention whatsoever of **an inductive sensor**. As such, this rejection should be withdrawn for this reason alone.

Moreover, the assertion contained on page 2 of the Office Action that the **magnet** 5 constitute receiver circuit traces demonstrates that the present rejection is apparently based on a misapprehension of the claimed subject matter and/or the description by Seger et al. In paragraph 0018, Seger et al. plainly state that a "single-turn magnet" is one that is rotatable a maximum of 360 degrees for the maximum angular rotation of the input shaft and that a "multiple-turn magnet" is one that rotates through multiple revolutions for the maximum one revolution of the single-turn magnet. It is not apparent in what manner the magnet 5 can be considered to constitute "receiver circuit traces."

Furthermore, the magnet 5, which the Office Action considers to constitute "receiver circuit traces" is not "arranged on a first one of [at least two] circuit boards." In this regard, the Office Action apparently is based on a

misapprehension of the statement appearing in paragraph 0044 of Seger et al. In this regard, Seger et al. state that “[t]he output gear 18, single-turn magnet 5, and shaft 23 rotate on bearings 14 which are mounted in plate 21 and printed circuit board 25.” Referring to Figure 6, it is plainly apparent that the foregoing statement should be understood to mean that the **bearings 14** are mounted in plate 21 and printed circuit board 25 not that the output gear 18, single-turn magnet 5 and shaft are mounted in the plate 21 and printed circuit board 25. Figure 6 plainly illustrates that the magnet 5 is not in any manner “arranged on a first one of [at least two] circuit boards.”

In addition, Seger et al. state that magnetic field sensors 6 positioned proximate the magnets sense associated magnetic fields as they rotate, that analog to digital converters 7 convert output signals from the magnetic field sensors 6 and that microprocessors 8 determine the angular positions of the sensor magnets from the digital signals from the analog to digital converters 7. As such, Seger et al. do not disclose, or even suggest, components of an evaluation electronic arrangement configured to evaluate signals that originate from receiver circuit traces.

It is “well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office.” Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Since Seger et al. fail to disclose, or even suggest, all of the features recited in claims 1 and 11, it is respectfully submitted that Seger et al. do not anticipate amended claims 1 and 11.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**III. Rejection of Claims 2 to 4, 6 to 8 and 10 Under 35 U.S.C. § 103(a)**

Claims 2 to 4, 6 to 8 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Seger et al., U.S. Patent Application Publication No. 2004/0095151 ("Schmidt et al.") and U.S. Patent No. 6,070,337 ("Wallrafen"). Applicant respectfully submits that the combination of Seger, Schmidt et al. and Wallrafen does not render unpatentable the present claims for at least the following reasons.

As an initial matter, U.S. Patent Application Publication No. 2004/0095151 is the national stage of PCT International Patent Application No. PCT/DE02/00396, having an international filing date after November 29, 2000. PCT International Patent Application No. PCT/DE02/00396 was published as WO 02/063343 in German. As such, U.S. Patent Application Publication No. 2004/0095151 does not constitute prior art against the present application. Withdrawal of this rejection is therefore respectfully requested.

Notwithstanding the foregoing, it is respectfully submitted that the combination of Seger et al., Schmidt et al. and Wallrafen does not render unpatentable the present claims for the following additional reasons. Claims 2 to 4 and 6 to 8 depend from claim 1 and therefore include all of the features included in claim 1, and claim 10 includes features analogous to features included in claim 1. As more fully set forth above, Seger et al. do not disclose, or even suggest, all of the features recited in claim 1. Neither Schmidt et al. nor Wallrafen is relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by Seger et al. Indeed, neither Schmidt et al. nor Wallrafen disclose, or even suggest, the features of claim 1 not disclosed or suggested by Seger et al. In this regard, Schmidt et al. relate to a capacitive sensor, and Wallrafen relate to a magnetic sensor.

In view of all of the foregoing, it is respectfully submitted that the combination of Seger et al., Schmidt et al. and Wallrafen does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Seger et al., Schmidt et al. and Wallrafen does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

#### **IV. Rejection of Claim 5 Under 35 U.S.C. § 103(a)**

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Seger et al., Schmidt et al. and U.S. Patent No. 5,947,691 ("Brown et al."). Applicant respectfully submits that the combination of Seger et al., Schmidt et al. and Brown et al. does not render unpatentable claim 5 for at least the following reasons.

As more fully set forth above, U.S. Patent Application Publication No. 2004/0095151 does not constitute prior art against the present application, and the present rejection should be withdrawn for this reason alone.

Furthermore, claim 5 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, Seger et al. do not disclose, or even suggest, all of the features of claim 1. Neither Schmidt et al. nor Brown et al. are relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by Seger et al. Indeed, it is respectfully submitted that neither Schmidt et al. nor Brown et al. disclose, or even suggest, the features of claim 1 not disclosed or suggested by Seger et al. In this regard, Brown et al. mention magnetic sensors and make no mention whatsoever of an inductive sensor.

In view of all of the foregoing, it is respectfully submitted that the combination of Seger et al., Schmidt et al. and Brown et al. does not disclose, or even suggest, all of the features of claim 5. As such, it is respectfully submitted that the combination of Seger et al., Schmidt et al. and Brown et al. does not render unpatentable claim 5. Accordingly, withdrawal of the present rejection is respectfully requested.

#### **V. Rejection of Claim 9 Under 35 U.S.C. § 103(a)**

Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Seger et al. and U.S. Patent Application Publication No. 2001/0048313 ("Frank"). Applicant respectfully submits that the combination of Seger et al. and Frank does not render unpatentable claim 9 for at least the following reasons.

Claim 9 depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, Seger et al. do not disclose, or even suggest, all of the features of claim 1. Frank is not relied upon for disclosing or

suggesting the features of claim 1 not disclosed or suggested by Seger et al. Indeed, it is respectfully submitted that Frank does not disclose, or even suggest, the features of claim 1 not disclosed or suggested by Seger et al. Since the combination of Seger et al. and Frank does not disclose, or even suggest, all of the features of claim 1, from which claim 9 depends, it is respectfully submitted that the combination of Seger et al. and Frank does not render unpatentable claim 9.

In view of all of the foregoing, withdrawal of the present rejection is respectfully requested.

#### **VI. New Claims 12 to 14**

New claims 12 to 14 have been added. It is respectfully submitted that claims 12 to 14 add no new matter and are fully supported by the present application, including the Specification.

Since claim 12 depends from claim 1 and therefore includes all of the features of claim 1, it is respectfully submitted that claim 12 is patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 1.

Since claim 13 depends from claim 10 and therefore includes all of the features of claim 10, it is respectfully submitted that claim 13 is patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 10.

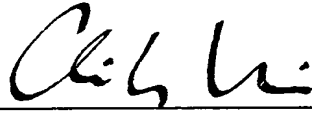
Since claim 14 depends from claim 11 and therefore includes all of the features of claim 11, it is respectfully submitted that claim 14 is patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 11.

**VII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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